

PATENT
10/039,956
Docket 091/009c

REMARKS

The Communication dated December 23, 2003, indicates that applicant's paper filed on October 23, with respect to the Restriction Requirement of September 23, was non-responsive, since it elected a claim that was not amongst the claims previously presented in the application.

Applicant respectfully disagrees. The paper filed on October 23 elected claim 37 (and any other claims falling within the same group) for examination on the merits. Like claim 16, the elected claim covers a method of screening additives to the culture environment using primate pluripotent stem cells. The Office has not shown how claim 37 is patentably distinct from claim 16, as required under MPEP § 816.

Furthermore, there is nothing in any of the statutes or regulations that prevent applicant from responding to a Restriction Requirement by presenting and electing a claim to a different invention disclosed in the specification as filed — for example, by canceling all previously pending claims, and presenting the new claim. This does not inconvenience the Office in any way, since the originally presented claims would not have been searched or examined — otherwise a restriction would not have been necessary.

Accordingly, the paper filed on October 23, 2003 was entirely proper and responsive to the Restriction Requirement of September 23, 2003.

Re-election of Group for Examination

So as to advance prosecution of the application, applicant hereby elects claim 16 (Group VI) for examination on the merits, along with any claims falling within the same group. Applicant respectfully submits that claims 37-52 also fall within the elected group, since they each depend directly or indirectly from claim 16, and incorporate its limitations.

Division between the elected group and any of the other groups indicated in the Restriction Requirement mailed September 23, 2003, is not traversed.

PATENT
10/039,956
Docket 091/009c

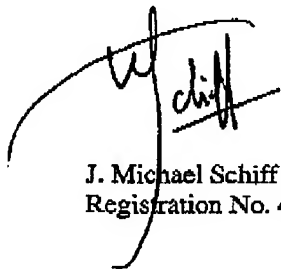
Conclusion

Applicants respectfully request that the application proceed to examination on the merits, in view of the amendment and remarks made herein.

In the event the Examiner determines that an interview would facilitate prosecution of this application, she is invited to contact applicant's representative at the telephone number indicated below.

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Michael Schiff", is written over a horizontal line.

J. Michael Schiff
Registration No. 40,253

GERON CORPORATION
230 Constitution Drive
Menlo Park, CA 94025
Telephone: (650) 473-7715
Fax: (650) 473-8654

January 9, 2004

geron

**J. Michael Schiff
GERON CORPORATION
230 Constitution Drive
Menlo Park, CA 94025
Phone: (650) 473-7715
Fax: (650) 473-8654**

Last page of this transmission